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EXAMINER

ALAVI, ALI

ART UNIT PAPER NUMBER

2875

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/699,112

Applicant(s)

ELSENER, KARL

Examiner

Ali Alavi

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51-61 is/are allowed.
- 6) ☒ Claim(s) 1-19, 28, 40-42 and 62 is/are rejected.
- 7) ☒ Claim(s) 20-27, 29-34, 36-39 and 43-50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

Claims 2-34, 36-50, and 52-60 are objected to because of the following informalities: The word "A" in the beginning of the claims should be changed to "The". Appropriate correction is required.

Claim 35 is objected to because it is incomplete. It appears that part of the claim that being depended on is left out.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 17-19, 28, 40-42 and 62 are rejected under 35 U.S.C. 102(b) as being anticipated Chen (US Pat. No 5,626,414).

Regarding claims 1 and 62, the applicant is advised that claims have been given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974), A pocket tool (folding knife) comprising: a housing body (11, fig. 1) having two mutually opposite side faces bounding defining at least a first housing (fig. 1) area between said side faces, at least a first implement (21, fig. 1) displaceable out of a stowed position

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(fig. 6) inside said first housing area into an operating position outside of said first housing area, wherein said first implement has, a housing case (211, fig. 1) with oppositely lying side walls having side faces extending substantially parallel and spaced apart from each other, and slim faces extending between said side walls (fig. 1), and at least one lighting means (laser diode 22) arranged on a slim face of said housing case and emitting a beam outwardly from said housing body and at an angle to a plane oriented perpendicular to said longitudinal axis of said pocket tool (figs 1 & 6).

Regarding claim 2, Chen further discloses that the angle of said beam is adjustable (because the implement 21 is pivotable thus the angle can be adjusted).

Regarding claim 3, Chen further discloses that lighting means is an LED (laser diode 22, col. 2, line 61).

Regarding claim 4, Chen further discloses that the angle of said beam is between approximately 0 and 170 (laser beam can normally be a narrow beam which meets this limitation).

Regarding claims 7-8, Chen further discloses that the first implement has at least one energy storage device (battery 24, fig. 1).

Regarding claim 17, Chen further discloses that the first implement has an electronic circuit for said lighting means (see fig. 1).

Regarding claim 18, Chen further discloses that the first implement has a switch (213, fig. 2) mechanism for said lighting means.

Regarding claim 19, Chen further discloses that the switch mechanism has an operating element provided on another, feely accessible slim face of said housing case

remote from said housing body when said first implement is in said stowed position and said operating position (fig. 6).

Regarding claim 28, Chen further discloses that the housing body has a base plate 12, fig. 1) and a cover plate (11) lying opposite each other and coupled to each other; said base plate and said cover plate form parallel mutually facing internal side faces in at least certain regions; and housing areas, separated from one another in at least certain regions by means of webs, extend between and in a plane parallel to said base plate and said cover plate for said displaceable first implement and at least one other removable implement (fig. 1).

Regarding claim 40, Chen further discloses that the implement can be locked in its stowed position and/or operating position by means of a catch or snap-fit mechanism provided between it and said housing body (123, fig. 6).

Regarding claim 41, Chen further discloses that said first implement has a lighting means housing pivotably mounted about an axis oriented perpendicular to said side faces and in which said at least one lighting means is accommodated (fig. 6).

Regarding claim 42, Chen further discloses that said housing case has two housing parts respectively forming said side walls; and said slim faces project out vertically from said side walls (fig. 1).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (US Pat. No 5,626,414) in view of Gardiner et al (US 2004/0016058 A1).

Chen discloses the claimed invention except for the power consumer, display unit, LCD display. Gardiner discloses a multi-purpose equipment including at least one power consumer, LCD (228, fig. 8), temperature sensor (286, fig. 8), (processor (288, fig. 8), magnetic sensor (282, fig. 8), and a global positioning system receiver (paragraph 12) in addition to the lighting means. Gardiner teaches that a multi-purpose equipment can be accommodated to have a wide variety of electronic/mechanical devices and accessories in many different combinations in an attractive and easy to use hand held housing.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a wide variety of other electronic/mechanical devices such as timer, clock, GPS (global positioning system) into the Chen device as taught by Gardiner in order to provide a handheld tool product having the tools and equipment necessary for a person to survive in remote outdoor environment.

#### ***Allowable Subject Matter***

Claims 20-27, 29-34, 36-39 and 43-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 51-61 are allowed.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walker (US Pat. No 6,142,769), Park (US Pat. No 5,653,525), McIntosh (US Pat. No 6,041,505) all are cited of interest..

Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Ali Alavi** whose telephone number is **(571) 272-2365**. The examiner can normally be reached between 7:00 A.M. to 5:30 P.M. Tuesday to Friday. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Sandy O'Shea can be reached at (571) 272-2378 or you may fax your inquiry to the **Central Fax at (703) 872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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AU 2875